

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
REPLY BRIEF**

To be argued by
Paul J. Sutton

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

76-7041

Appeal No. 76-7041

GEORGE LERNER and
JULIUS ELLMAN,

Plaintiffs-Appellants,

-against-

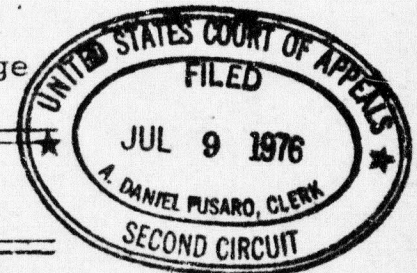
CHILD GUIDANCE PRODUCTS, INC. and
QUESTOR CORPORATION,

Defendants-Appellees.

Appeal From the United States District Court
For the Southern District of New York

Honorable William C. Conner, District Judge

REPLY BRIEF OF PLAINTIFFS-APPELLANTS



PAUL J. SUTTON
BARRY G. MAGIDOFF

Attorneys for
Plaintiffs-Appellants

MISKIN & SUTTON
521 Fifth Avenue
New York, N.Y. 10017

Of Counsel

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REFERENCES

As used herein "defendants" refers to defendants-appellees Child Guidance Products, Inc. and Questor Corporation except where the context requires otherwise, and "Lerner and Ellman" refers to plaintiffs-appellants George Lerner and Julius Ellman.

Volume I of the two volumes of the appendix is cited "(A___)" followed by the page number. Volume II of the appendix consists of the transcript of the District Court Trial, in its entirety, and is cited "(Tr. ___)" followed by the transcript page number.

When reference is made to trial exhibits, they are cited "(PX___)" and "(DX___)" for plaintiffs-appellants and defendants-appellees, respectively.

Emphasis in quotations has been added throughout this brief unless otherwise indicated.

UNITED STATES COURT OF APPEALS
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Appeal No. 76-7041

GEORGE LERNER and
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-against-

CHILD GUIDANCE PRODUCTS, INC. and
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Defendants-Appellees.

REPLY BRIEF OF
PLAINTIFFS-APPELLANTS

I. Introduction

Defendants-Appellees have chosen not to address themselves to the three questions presented to this Court in the brief of plaintiffs-appellants. Instead, a heavily "loaded" counter-statement of questions is presented which begs the very questions under consideration, and which does not directly address itself to the District Court proceedings and the errors enumerated in plaintiffs-appellants' brief.

Defendants-appellees apparently concede that the District Court incorrectly applied the law, and rely at least

in part upon procedural points (e.g. the order of the trial) which have no relevance to the substantive rights of patent owners as to the validity of patent claims in suit. Lest their silence be misconstrued, plaintiffs-appellants will hereinafter argue certain issues raised in defendants-appellees answering brief.

II. Defendants-Appellees Rely In Their Answering Brief Entirely Upon The Bienengraber Reference Which Was Cited By The Patent Office Examiner

Defendants-appellees, in attempting to convince us that the patent in suit (PX 1, A 37) is invalid under 35 U.S.C. 103, rely in their answering brief solely upon the Bienengraber patent reference (A 327). Bienengraber was cited and considered by the Patent Office Examiner responsible for allowing the issuance of the patent in suit.

The District Court correctly stated the presumption of validity and the burden upon the defendants of establishing invalidity in accordance with 35 U.S.C. 282. This presumption of validity carries with it the Patent Office consideration of Bienengraber, and defendants-appellees have simply not overcome this presumption. Their silence as to the Bassler patent (A 333-356) reflects an admission that this reference is less relevant than those cited by the Patent Office.

III. The Patent Claim In Suit Is Patentable Over The Cited Bienengraber Reference

Claim 1 of the patent suit is not anticipated by Bienengraber, as recognized by the actions of the Patent Office

Examiner. In the Official Action dated April 13, 1956 (A 71), the Examiner cited Bienengraber against the patent application which eventuated into the patent in suit (PX 1, A 37). In a response to this Action received by the Patent Office on October 1, 1956 (A 73-76), Musser argued for patentability over Bienengraber.

Again, on July 17, 1957 the Patent Office rejected Musser's claims (A 77-79), renewing its reference to Bienengraber. Again, and subsequently, Musser argued and distinguished his invention over Bienengraber (A 80-94; A 117-126) until the patent in suit was granted. In fact, a rather exhaustive prosecution of Musser's applications took place commencing with the filing of his first patent application on January 26, 1956 until more than three years later, February 17, 1959, when Musser was granted his patent (PX 1, A 37).

Defendants-appellees' second question at the bottom of page 1 of their brief dealing with the omission of elements, clearly ignores established law, and unquestionably can be answered in the affirmative. Circuit Courts, District Courts, the Patent Office Board of Appeals, and the Court of Customs and Patent Appeals have all long recognized - that it may be patentably unobvious under 35 U.S.C. 103 to omit one or more structural elements of an invention while retaining its or their function.

The Seventh Circuit Court of Appeals in Glade v. Walgreen Co., 122 F.2d 306, 50 USPQ 407 (1941), cert. denied

314 U.S. 692, 51 USPQ 547 stated, at page 309, 50 USPQ at 409-410:

"We find nothing in the statute, or in the decisions cited, which would preclude plaintiff from receiving a patent for a combination, even though it produced the same result as other such devices, if it produced that result with fewer elements than had theretofore been used or thought necessary. This is precisely what plaintiff did. Theretofore others had produced the same general result with five or more elements, whereas plaintiff produced the same general result more efficiently with three elements. It is not fair to say that Martin uses the same old elements as those before him, for there are at least two of the old elements used in prior devices which Martin does not use at all. In other words, he produces the same result in a more efficient and facile manner by making three of those old elements accomplish the same general result as five or more had theretofore done."

See also Everest v. Duke, 139 F.2d 22, 60 USPQ 56, 7th Cir. 1943; Ex Parte Seastone and Brandt, (PO BdApp. 1946), 72 USPQ 13; In re Stacy, (CCPA 1943), 135 F.2d 232, 57 USPQ 307; In re Blair, (CCPA 1944), 142 F.2d 289, 61 USPQ 355; In re Anthony and Friang (CCPA 1945), 147 F.2d 695, 64 USPQ 553; In re Fleissner, (CCPA 1959), 264 F.2d 897, 121 USPQ 270 stating: "...It may be unobvious to omit an element while retaining its function."; and In re Edge, (CCPA 1966), 359 F.2d 896, 149 USPQ 556, stating: "While it may often be true that the mere omission of an element together with its function does not produce a patentable invention, it may also be unobvious to omit an element while retaining its function.".

Yes, the Musser invention is considerably simpler, less expensive, capable of mass production, and designed as a toy - as compared with Bienengraber and its complex linkages

which are only practicable in such a device of several hundred pounds. Musser eliminates the linkage, while retaining its function - bringing tone bars into contact with rotating washers.

In rejecting the faulty "hindsight" approach to determining "obviousness", the District Court for the Western District of North Carolina (citing Glade, supra) stated:

"The mere fact that an invention may seem simple and clear after it is explained or that the inventive concept is carried out by individual elements known in the art does not make it obvious. In Manville Boiler Co. v. Columbia Boiler Co. of Pottstown, 269 F.2d 600, 122 USPQ 545 (4th Cir. 1959), cert. denied 361 U.S. 901, 123 USPQ 590 (1959), the Court stated, at Page 604, 122 USPQ at 547-548:

'After Mandleburg pointed the way, the solution may seem simple and obvious, but it hardly can be said to have been obvious in a legal sense when Columbia's skilled craftsmen could not provide the answer, though the desirability of improvement had been recognized for many years. As Judge Sobeloff said in S.H. Kress & Company v. Agnides, 4 Cir., 246 F.2d 718, 723, 113 USPQ 395, 399:

'The usual defense that the result would have been obvious to one skilled in the art cannot avail the defendant here. Obviousness does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else; the test of obviousness is as of an earlier time, when the search is on...'

The often quoted Second Circuit statement of Judge Haugh in Kurtz v. Belle Hat Lining Co., 280 F.277,281 is appropriate, namely:

"The imitation of a thing patented by a defendant who denies invention, has often been regarded perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think."

a principle well recognized in this Circuit.

In the present case, Musser's claim 1 of the patent in suit is a combination claim - a claim reciting a combination of elements which provide advantages enumerated in the patent specification. These advantages and the goals sought by Musser were never even contemplated by Bienengraber who had a different goal in mind. More specifically, Musser sought to provide a toy for children (A 39, Column 1, lines 20-25); capable of being mass produced (A 39, Column 1, lines 30-32); of simple construction and low cost (A 39, Column 1, line 33); and of light and rugged construction immune to a normal child's destructive propensities (A 39, Column 1, lines 37-42); and capable of producing carillon or organ-like melodious tones (A 39, Column 1, lines 43-46).

Inherent in these aims of Musser is the avoidance of complex linkages which require increased costs and increased weight, not to mention their susceptibility to child-caused damage, matter never considered by Bienengraber because of his interest in accomplishing an entirely distinct result.

IV. There Is No Evidence To Contradict The Plaintiffs-Appellants' Evidence of Commercial Success

The District Court, in weighing the evidence presented by plaintiffs-appellants establishing commercial success stated:

"There has been no contradiction or no question concerning that evidence, so I consider it more or less undisputed that the ...device shown in the patent... did enjoy a substantial degree of commercial success, and I am willing to accept that in my determination" (Tr 364). Emphasis added.

When counsel for defendants-appellees was asked if he disputed the fact that the Musser Bell Organ (PX 3) enjoyed significant commercial success, Mr. Russell replied:

"...Here I certainly have to agree, I have no evidence to dispute the fact that the thing went into commercial success..." (Tr 365-366). Emphasis added.

Defendants-appellees should not now be heard to dispute this evidence without evidence to support their beliefs.

V. Conclusion

For all of the above reasons and those set forth in their principal brief, Lerner and Ellman respectfully repeat their request for the following relief.

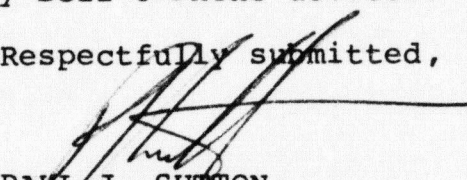
1. That that part of the judgment of the District Court dismissing the Complaint be reversed.

2. That that part of the judgment of the District Court holding claims 1, 2, 3, 7, 8 and 9 invalid under 35 U.S.C. 103 be reversed.

3. That a holding of infringement by defendants be made as regards the Big Mouth Singers device alone.

4. That a holding of non-infringement by defendants be made as regards both Melody Bell-O-Phone devices.

Respectfully submitted,



PAUL J. SUTTON
BARRY G. MAGIDOFF

Attorneys for
Plaintiffs-Appellants

Of Counsel:

MISKIN & SUTTON
521 Fifth Avenue
New York, New York 10017

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that true copies of the
foregoing Brief were mailed this 9th day of July, 1976
to:

ROBERT B. RUSSELL, ESQ.
ELMER GORN, ESQ.
RUSSELL & NIELDS
One Boston Place
Boston, Massachusetts 02103; and

ELIAS MESSING, ESQ.
HAYS, ST. JOHN, ABRAMSON & HEILBRON
120 Broadway
New York, New York 10005; and

DONALD R. BAHR, ESQ.
Patent Counsel
Questor Corporation
1801 Spielbusch Avenue
Toledo, Ohio 43601

Attorneys for Defendants-Appellees

A handwritten signature in dark ink, consisting of several overlapping, stylized strokes, positioned below the text "Attorneys for Defendants-Appellees".